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No. 84-975

In The
Supreme Court of the United States
October Term, 1984

DEERE & COMPANY,

Petitioner,

v.

JON E. KINZENBAW and
KINZE MANUFACTURING, INC.,

Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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41

TABLE OF CONTENTS

	Page
STATEMENT OF THE CASE	1
A. Background Facts	1
B. Proceedings in the District Court	2
C. The Court of Appeals Decision	4
REASONS FOR DENYING THE WRIT	6
Summary	6
I. Issues Undecided by the Court of Appeals Are Not Ripe For Review on the Merits	8
II. The Unreviewed Judgment of the District Court Has No Collateral Estoppel Effect and is Not a Taking Without Due Process	9
III. The Court of Appeals Applied Well-Settled Principles of Patent Law in Holding That the Scope of the Pust Patent Cannot Be Enlarged by Equivalents	13
IV. The Court of Appeals' Conclusion Concerning Deere's Failure to Move for Directed Verdict Is Squarely Based On Settled Law and Does Not Merit Review	17
V. In Upholding the Invalidity of the Brass Patent for Prior Public Use, Well-Settled Principles of Patent Law Were Applied	21
CONCLUSION	25

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Aetna Life Insurance Co. v. Haworth, 300 U.S. 227 (1937)	13
Allen v. McCurry, 449 U.S. 90 (1980)	12
Bivens v. Six Unknown Named Agents of Federal Bureau of Narcotics, 403 U.S. 388 (1971)	8

TABLE OF AUTHORITIES CITED—Continued

Pages

Bohrer v. Hanes Corporation, 715 F.2d 213 (5th Cir. 1983) 19

Breen v. Centex Corp., 695 F.2d 907 (5th Cir. 1983) 11

Brown v. Felsen, 442 U.S. 127 (1979) 12

Church of Scientology of California v. Linberg, 529 F.Supp. 945 (C.D. Cal. 1981) 12

City of Elizabeth v. American Nicholson Pavement Co., 97 U.S. 126 (1877) 25

Exhibit Supply Co. v. Ace Corp., 315 U.S. 126 (1942) ... 14

Fire Insurance Association v. Wickham, 128 U.S. 425 (1888) 21

Flast v. Cohen, 392 U.S. 83 (1958) 13

G. & C. Merriam Co. v. Saalfield, 241 U.S. 22 (1916) 12

Getty v. Lane, 262 F. 141 (1919) 16

Graham v. John Deere Co., 383 U.S. 1 (1966) 14

Graver Mfg. Co. v. Linde Co., 339 U.S. 605 (1950) 13

Graver Mfg. Co. v. Linde Co., 336 U.S. 271 (1948) 21

Hanahville Indian Community v. U.S., 180 Ct. Cl. 477 (Ct. Cl. 1967) 11

Hicks v. Quaker Oats Co., 662 F.2d 1158 (5th Cir. 1982) 12

Hughes Aircraft, 717 F.2d at 1362, 219 USPQ at 481 16

International Refugee Organization v. Republic S.S. Corp., 189 F.2d 858 (4th Cir. 1951) 11

Jewell v. Knight, 123 U.S. 426 (1887) 21

Kremer v. Chemical Construction Co., 456 U.S. 461 (1982) 12

TABLE OF AUTHORITIES CITED—Continued

Pages

Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516 (2d Cir. 1946), *cert. denied*, 328 U.S. 840 (1946) 24

Montana v. U.S., 440 U.S. 147 (1979) 12

Moran Towing & Transportation Co., Inc. v. Navigazione Liberia Triestina, S.A., 92 F.2d 37 (2d Cir. 1937), *cert. denied*, 302 U.S. 744 (1937) 11

North Carolina v. Rice, 404 U.S. 244 (1971) 13

Pennock v. Dialogue, 27 U.S. (2 Pet.) 1 (1829) 23

Perth Amboy National Bank v. Brodsky, 207 F. Supp. 785 (S.D. N.Y. 1962) 12

Plastic Container Corp. v. Continental Plastics of Oklahoma, Inc., 607 F.2d 885 (10th Cir. 1979) 12

Rochester Civil Theatre, Inc. v. Ramsay, 368 F.2d 748 (8th Cir. 1966) 19

Rufendcht v. Iowa Beef Processors, Inc., 492 F. Supp. 877 (N.E. Tex. 1980) 12

Schriber Co. v. Cleveland Trust Co., 311 U.S. 211 (1940) 14

Standard Oil Co. of California v. U.S., 685 F.2d 1337 (Ct. Cl. 1982) 12

Stebbins v. Keystone Insurance Co., 481 F.2d 501 (D.C. Cir. 1973) 12

St. Joseph Union Depot Co. v. Chicago, RI & P. Ry. Co., 89 F. 648 (8th Cir. 1898), *cert. denied*, 172 U.S. 694 (1899) 11

United Automobile, Aerospace and Agricultural Implement Workers of America, UAW v. NLRB, 462 F.2d 298 (D.C. Cir. 1972) 10

United States v. United Continental Tuna Corporation, 425 U.S. 164 (1976) 8

TABLE OF AUTHORITIES CITED—Continued

Pages

U.S. Industries, Inc. v. Blake Construction Co., 671 F.2d 539 (D.C. Cir. 1982) 17

White v. Dunbar, 119 U.S. 47 (1886) 16

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§ 102(a) 3, 8

§ 102(b) 3, 8

§ 103 ..... 2, 3, 21

§ 112 3

RULE 28.1 STATEMENT

Kinze Manufacturing, Inc. has no parent company nor any subsidiaries or affiliates.

NOTE TO RECORD REFERENCES AND ABBREVIATIONS

The record in the Court of Appeals consists of seventeen volumes: Volumes I-X include the docket entries, pleadings and trial transcript, Volumes XI-XVII are exhibits. Thus, references in the form XIII:4305 mean Volume XIII, page 4305.

As used herein, "PB" refers to Petitioner's Brief; "RB" to Respondent's Brief; "Kinze" to respondents collectively; and "Deere" to petitioner.

References to sections, such as § 103, all refer to the Patent Laws, Title 35, United States Code.

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RESPONDENTS' BRIEF IN OPPOSITION

STATEMENT OF THE CASE

A. Background Facts

We adopt wholeheartedly the history of this arduous and complex litigation as stated by the Court of Appeals at PB 5a-7a.

Deere's statement of the case, completely ignoring the antitrust background of this case, accuses Kinze of "piracy". However, the Court of Appeals noted that Kinze copied the Deere row unit because: (1) Deere had breached a 1977 Settlement Agreement of Kinze's anti-

trust claim by failing to provide "unassociated" row units as it had agreed (PB 5a), (2) Deere had resumed its illegal tie-in of the row units (PB 6a) which rendered any patents covering them unenforceable; and (3) Kinze had been advised by its counsel that Deere's patents were invalid (PB 5a).

B. Proceedings in the District Court

In the 14 day trial, 18 witnesses testified, more than 2800 pages of trial transcript were compiled and thousands of pages of exhibits were admitted. Contrary to Deere's suggestion at PB 9, it was Deere, not Kinze, who insisted the patent issues be tried before a jury (see I:8, docket Nos. 279 and 284 and I:9, docket No. 318). The jury, after deliberating for 3 days, made a total of 35 findings*—18 in favor of Deere and 17 in favor of Kinze. Every patent in suit was found invalid, not infringed or unenforceable on at least two independent grounds (PB 6a).

Pust. The jury found this patent unenforceable for misconduct before the U.S. Patent and Trademark Office (PTO) (Interrog. 7) and bolstered that verdict by finding the prior art withheld by Pust was more pertinent than that known by the Examiner (Interrog. 6). It also found, in response to Interrogatory 13, that there is no literal infringement of the Pust patent, as Deere has since conceded.

Hansen. The jury found invalidity on three independent grounds: Obviousness under § 103 (Interrog. 5);

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* Appendix A-I is a chart which illustrates the issues decided by the jury. Boxes blacked out indicate issues not submitted. An "X" indicates a verdict for Kinze on that issue. A blank indicates a verdict for Deere.

failure to set forth an enabling disclosure of the invention required by § 112 (Interrog. 3); and known or used by others under § 102(a) (Interrog. 4).

Brass-Hansen. The jury found invalidity or unenforceability on five independent grounds: (1) known or used by others prior to the invention under § 102(a) (Interrog. 4); (2) obviousness under § 103 (Interrog. 5); (3) procured through misconduct (Interrog. 7); (4) in public use more than a year before the date of the application under § 102(b) (Interrog. 10); and (5) on sale more than one year before the date of the application under § 102b (Interrog. 11). The jury bolstered both the obviousness and misconduct verdicts by finding that the Examiner was unaware of the most pertinent prior art (Interrog. 6) though Deere was well aware of it.

Brass. The Jury found the patent invalid for obviousness under § 103 (Interrog. 5) and for public use more than a year before the application was filed (Interrog. 10), and it bolstered the obviousness finding with a separate finding that the most pertinent prior art was not before the Examiner when he allowed the application (Interrog. 6).

At the close of all the evidence, Deere failed to move for directed verdict on two issues—invalidity of the Hansen '601 and Brass-Hansen '668 patents under § 102(a) (Interrog. 4).

The trial court concurred with the jury's findings on obviousness of the Keeton, Hansen, Brass-Hansen and Brass patents; and, as a matter of law, it concluded these patents invalid for obviousness (PB 19a-21a). The trial court also held the Pust and Brass-Hansen patents unen-

forceable because of misconduct before the PTO. The trial court denied Deere's motions for directed verdict and for judgment NOV because on its review of the record, there was sufficient evidence to support all the jury's verdicts. (PB 18a-24a).

After the jury found that the Pust patent was not literally infringed (Interrog. 13), the trial court ruled, as a matter of law, that the Kinze planter does not infringe the Pust patent.* As the Court of Appeals noted; the district court "applied the doctrine of prosecution history estoppel to preclude Deere from relying upon the doctrine of equivalents" because "Pust had intentionally narrowed his claims in order to avoid the examiner's rejection and obtain the patent" (PB 13a).

C. The Court of Appeals Decision

Deere assigned no error on appeal to any of the jury instructions, and did not appeal any of the evidentiary rulings of the trial court. Nor did Deere appeal for a new trial before the Federal Circuit. The only issues raised by Deere on appeal were: (1) The correctness of the district court's ruling against Deere on the issue of file wrapper estoppel on the Pust patent; and (2) the sufficiency of the evidence to support the 17 jury determinations adverse to Deere.

The Court of Appeals' decision was unanimous—written by Judge Friedman speaking for the five senior judges of that Court, Chief Judge Markey presiding.

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* Deere conveniently did not include in its Petition the trial Court's Decision on this important ruling. It is included here as Appendix A-II, RB 2a-5a.

In the Court of Appeals, as it does here, Deere made a "sweeping attack" on the jury (PB 7a), accusing it of deciding (only the 17 determinations adverse to Deere, obviously) with passion and prejudice. The Court of Appeals rejected that unfounded complaint and stated:

> This charge seems somewhat implausible in view of the fact that the jury decided 18 of the questions in favor of Deere and only 17 in favor of Kinze. The verdict did not indicate that the jury took a one-sided view of the evidence. In any case, the record does not support this allegation. (PB 7a)

Dispositive of this concocted issue is the fact that Deere does not point to a single bit of *evidence* that it alleges was improperly admitted or falsely portrayed. Deere alleges, quite unfairly, that Kinze's trial counsel used exaggerated analogies in his argument. However, the jury was properly instructed that "[S]tatements of counsel are not evidence in the case . . . you are to consider only the evidence in the case . . ." (PB 22a).*

The Court of Appeals affirmed the trial court on a single ground in respect of each of the four patents at issue here. The Court of Appeals also found that the art of planters is well-established (PB 4a, 10a), and that each of the four patents still at issue represents a minor improvement in a crowded art (PB 5a, 11a, 14a). With respect to the Pust patent, the Court of Appeals affirmed

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* The trial court properly treated any such errors in the conduct of the trial only as grounds for a new trial, not for judgment NOV (PB 19a). Deere, however, did not support its allegations before the trial court with any specifics, only "conclusory allegations" and without any supporting authority (PB 22a). The trial court concluded based on its independent examination of the record that there were no comments by counsel "which would warrant a new trial" (PB 22a).

the trial court's holding of non-infringement as a matter of law.

The Court of Appeals upheld the verdicts on the Hansen and Brass-Hansen patents under § 102(a) because Deere had waived its right to appellate review of the sufficiency of the evidence by failing to include those issues in its motion for a directed verdict. The Court of Appeals also upheld the trial court's denial of Deere's motion JNOV in connection with the Brass patent because the invention was in public use more than a year before the patent application was filed, 35 U.S.C. 102(b).

What the Court of Appeals did *not* hold is, under the circumstances here, as important as what it did. For example, see pages 2-3 *supra,* for a discussion of the verdicts which the Court of Appeals did *not* review.

We do not address here any issue not actually decided by the Court of Appeals. This does not mean, however, that we concur with Deere's one-sided presentation of the evidence on those undecided issues.

REASONS FOR DENYING THE WRIT

Summary

This is an ordinary patent case between two private litigants. Nothing about it warrants review by this Court. It raises no new or unsettled questions of law nor any questions of special public importance.

Deere's primary ground for review is a bogus Constitutional issue, but Deere also argues for review simply because the Court of Appeals refused to make a broad

exception to the express requirements of Rule 50, Fed. R. Civ. P., a decision by that Court which was manifestly correct. Deere raises two issues of Patent Law which the five judge panel of the Court of Appeals, specializing as it does in patent cases such as this, unanimously decided against Deere, applying well-settled principles of validity and infringement established by many prior decisions of this Court.

Deere cites no conflict between the decision of the Court of Appeals and that of this or any other court, no departure from settled law which calls for the exercise of this Court's supervisory powers and no decision on any as yet unresolved question of law.

Deere raises other issues left undecided by the Court of Appeals, which ruled on independent alternative grounds. Those issues on which the Court of Appeals did not rule provide no basis for review in this Court.

We are confident that this Court will not be swayed by Deere's attempts to portray this case as justice gone awry. Deere has had the opportunity in the district court and the Court of Appeals to argue its version of this case. Merely because those courts refused to accept Deere's erroneous contentions does not transform an otherwise straightforward case into one which "cries out for this Court's review". We submit that Deere's petition fails to raise a single argument which this Court ought seriously consider as grounds for granting a petition for certiorari.

In sum, this case ought not be reviewed.

I. Issues Undecided by the Court of Appeals Are Not Ripe For Review on the Merits

Deere petitions for certiorari regarding four* rulings by the district court which the Court of Appeals did not reach, because it affirmed on other independent grounds. The Court of Appeals specifically noted that it was unnecessary to address these questions in view of the independent grounds for affirmance (PB 8a).

The four issues not decided by the Court of Appeals, but raised in Deere's petition, would be reached only if this Court granted certiorari on each of the questions actually addressed by the Court of Appeals, and reversed the Court of Appeals. In such a circumstance, this Court's practice is to remand the questions previously unaddressed on appeal to the Court of Appeals for its ruling. See, *Bivens v. Six Unknown Named Agents of Federal Bureau of Narcotics,* 403 U.S. 388, 397-398 (1971), and *United States v. United Continental Tuna Corporation,* 425 U.S. 164, 182 (1976). As a result, alleged errors in the district court's rulings on these issues are not proper grounds for seeking this Court's review.

Therefore, we decline to respond to the merits of Deere's contentions that there was insufficient evidence to support the jury's findings that: The Pust patent is unenforceable because procured through misconduct (PB 12-14); the Brass-Hansen and Hansen patents are invalid

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* Re Pust—Misconduct; re Brass-Hansen and Hansen—prior knowledge or use under §102(a); re Brass-Hansen—prior public use under §102(b).

under § 102(a) (PB 18-19); and the Brass-Hansen patent is invalid under § 102(b) (PB 19-22)*.

We will not address the merits of these undecided issues because they are irrelevant as to whether this Court should grant certiorari to review the actual rulings of the Court of Appeals.

II. The Unreviewed Judgment of the District Court Has No Collateral Estoppel Effect and is Not a Taking Without Due Process

Deere's argument that the Court of Appeals' failure to review the district court's determination that the Pust patent was unenforceable deprived Deere of property without due process is grounded on a gross legal error—that the district court's finding will be binding as collateral estoppel in a future infringement action.

The district court concluded as a matter of law that the Pust patent was not infringed and entered judgment on the jury's finding that the Pust patent was not enforceable because procured by inequitable conduct. Thus, the district court's judgment in favor of Kinze was predicated on the independent alternative grounds of unenforceability and non-infringement. Deere appealed that judgment.

The Court of Appeals affirmed the district court on the non-infringement ground, but adhering to the funda-

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* Confusion wrought by Deere's intermingling of issues actually reviewed by the Court of Appeals with those not reviewed is compounded by Deere's erroneous reference to the Hansen patent having been held invalid for "public use" under §102(b) (PB 19). The Brass patent, not the Hansen patent, was declared invalid on that ground, and that ruling was affirmed by the Court of Appeals.

mental principle that no appellate court is required to or should adjudicate unnecessary questions, did not pass on the alternative non-enforceability ground. *United Automobile, Aerospace and Agricultural Implement Workers of America, UAW v. NLRB*, 462 F.2d 298, 300 (D.C. Cir. 1972).

Deere now contends that this Court should grant certiorari to review what Deere claims to be an important constitutional question raised by the Court of Appeals' refusal to review the alternative independent ground for the district court's judgment, i.e., that the Pust patent is unenforceable. Deere reasons that if it were to sue another hypothetical infringer, that defendant could assert the district court's finding of misconduct under the doctrine of collateral estoppel, even though the Court of Appeals did not address that question. Deere cites no authority for that premise, and it is blatantly false. Based on this erroneous premise, Deere concludes that it has been denied property (its rights in the Pust patent which expires in two years) without due process (appellate review). Deere also cites no authority for its conclusion that this hypothetical future estoppel by judgment has deprived it of property now.

The law is clear that an alternative ground for a district court's judgment which is appealed but goes unreviewed is not a binding determination which will preclude litigation of that issue in a future action. Both Professors Wright and Moore in their acclaimed treatises succinctly and unequivocally state the principle.* Further,

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* As Professor Wright puts it:

As to matters passed over by the appellate court, however, preclusion is not available on the basis of the trial

(Continued on next page)

this principle has been included in the Restatement of the Law of Judgments since 1942.*

The decisions of the Courts of Appeals which support these treatise and restatement conclusions are univocal: An alternative ground for the district court's judgment which is appealed but not reviewed is entitled to no collateral estoppel effect. *Breen v. Centex Corp.*, 695 F.2d 907, 915 (5th Cir. 1983); *International Refugee Organization v. Republic S.S. Corp.*, 189 F.2d 858, 862 (4th Cir. 1951); *Moran Towing & Transportation Co., Inc. v. Navigazione Liberia Triestina, S.A.*, 92 F.2d 37, 40-41 (2d Cir. 1937), *cert. denied*, 302 U.S. 744 (1937); *St. Joseph Union Depot Co. v. Chicago, RI & P. Ry. Co.*, 89 F. 648, 653 (8th Cir. 1898), *cert. denied*, 172 U.S. 694 (1899); *Hanahville Indian Community v. U.S.*, 180 Ct. Cl. 477, 485 (Ct. Cl.

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court decision. This result is supported by the fact that the appellate choice of grounds for decision has made unavailable appellate review of the alternative grounds. The federal decisions agree that once an appellate court has affirmed on one ground and passed over another, preclusion does not attach to the ground omitted from its decision. Wright & Miller, § 4421 at p. 205.

Professor Moore concurs:

Thus if the trial court rests its judgment on two grounds, each of which is independently adequate to support it, the judgment is conclusive as to both; but if the appellate court affirms on one ground without passing on the other, the second ground is no longer conclusively established under the collateral estoppel doctrine. Moore, para. 0.416[2] at p. 518.

* The Restatement contains several pronouncements of the same conclusion. See, Restatement of the Law of Judgments (1942), § 69(2), Comment (b) to § 69 and Comment (n) to § 68.

1967); *Standard Oil Co. of California v. U.S.*, 685 F.2d 1337, 1341-1342 (Ct. Cl. 1982).*

These decisions are nothing more than an application of the fundamental rules of issue preclusion by judgment. The absence of appellate review deprives the litigant of a full and fair adjudication on the unreviewed issue, which is a prerequisite to estoppel by judgment. *Kremer v. Chemical Construction Co.*, 456 U.S. 461 (1982); *Allen v. McCurry*, 449 U.S. 90, 95 (1980). Further, because the district court judgment has been merged into the judgment of the Court of Appeals, the district court judgment is not the final judgment, and only final judgments can gave rise to issue preclusion by estoppel. *G. & C. Merriam Co. v. Saalfield*, 241 U.S. 22, 28-29 (1916). Finally, collateral estoppel can only apply to preclude relitigation of issues which were actually and necessarily determined in the prior action. *Brown v. Felsen*, 442 U.S. 127, 137, 139 n.10 (1979); *Montana v. U.S.*, 440 U.S. 147, 153 (1979). Where the Court of Appeals fails to address an issue, no such determination has been made.

The Court of Appeals' decision did not unconstitutionally deprive Deere of any property interest** in the

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* Other Courts of Appeals' decisions, although not specifically grounded on the application of this principle, have nonetheless embraced it as correct. *Stebbins v. Keystone Insurance Co.*, 481 F.2d 501, 507 n.13 (D.C. Cir. 1973); *Plastic Container Corp. v. Continental Plastics of Oklahoma, Inc.*, 607 F.2d 885, 892 and 892 n.11 (10th Cir. 1979); *Hicks v. Quaker Oats Co.*, 662 F.2d 1158, 1168 and 1168 n.6 (5th Cir. 1982). The district courts have applied this principle without fail. *Church of Scientology of California v. Linberg*, 529 F.Supp. 945, 965-966 (C.D. Cal. 1981); *Rufendcht v. Iowa Beef Processors, Inc.*, 492 F.Supp. 877, 884 (N.E. Tex. 1980); *Perth Amboy National Bank v. Brodsky*, 207 F.Supp. 785, 788 (S.D. N.Y. 1962).

** Until a future ruling (by an unspecified court in a hypothetical action between Deere and an infringer not a party

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Pust patent. Deere's bootstrap argument to that effect should be summarily rejected.

III. The Court of Appeals Applied Well-Settled Principles of Patent Law in Holding That the Scope of the Pust Patent Cannot Be Enlarged by Equivalents.

Deere charges (PB 14-16) that the Court of Appeals erred in failing to apply the doctrine of equivalents to enlarge the Pust claims beyond their literal scope, citing *Graver Mfg. Co. v. Linde Co.*, 339 U.S. 605 (1950).

The doctrine of equivalents is an exception to the primary rule of claim construction that patentees are limited to what is claimed. The doctrine is not applied in every case. As this Court pointed out in *Graver Mfg. Co., supra*, 339 U.S. at 608, the doctrine *may* be applied only "when the proper circumstances for its application arise."

It is well settled that two threshold criteria, both found applicable here by the Court of Appeals, bar application of the Doctrine of Equivalents:

(a) The doctrine of file wrapper estoppel precludes any expansion of the patent monopoly beyond its literal terms.

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here) holding the Pust patent unenforceable on collateral estoppel grounds, Deere has suffered no deprivation of property. This Court eschews advisory opinions in cases involving hypothetical future constitutional questions and refuses review where, as here, no justiciable case or ripe controversy exists between the parties to the action. *Flast v. Cohen*, 392 U.S. 83, 96 (1958); *Aetna Life Insurance Co. v. Haworth*, 300 U.S. 227, 240-241 (1937); *North Carolina v. Rice*, 404 U.S. 244, 246 (1971).

(b) A narrow improvement in a crowded art, as is the Pust invention, is not entitled to any scope beyond its literal terms.

Deere conceded on appeal that the Kinze structure does not literally infringe the claims of the Pust patent and the Court of Appeals so held (PB 12a).

Unchallenged by Deere are the holdings of the Court of Appeals: (i) that "the patentee [Pust] narrowed the claims by specifying the radius of the gauge wheels" following a rejection by the Patent Examiner that the broader original claim was unpatentable over the prior art, and (ii) Pust's insertion of that "limitation satisfied the Examiner, who issued the patent with the narrower claims" (PB 12a).

A patentee who surrenders subject matter during prosecution of his patent by voluntarily inserting limitations to overcome prior art rejections cannot, as a matter of law, resort to the doctrine of equivalents. He is barred from doing so by the doctrine of file wrapper estoppel (called "prosecution history estoppel" by the Federal Circuit, PB 13a). This fundamental principle was established in this Court over 50 years ago, *I.T.S. Co. v. Essex Co.*, 272 U.S. 429, 444 (1926). It has been repeatedly and consistently applied since that time in *Exhibit Supply Co. v. Ace Corp.*, 315 U.S. 126, 137 (1942), *Graham v. John Deere Co.*, 383 U.S. 1, 33, 34 (1966), and *Schriber Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220 (1940), where the Court stated:

> The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer.

As the Court of Appeals here found:

> The district court, however, applied the doctrine of prosecution history estoppel to preclude Deere from relying upon the doctrine of equivalents. Finding that Pust had intentionally narrowed his claims in order to avoid the examiner's rejection and obtain the patent, the court refused to permit Deere to avoid that limitation upon the claims through the doctrine of equivalents. The Court, therefore, held the accused Kinze device did not infringe the Pust patent.

Deere argued before both lower courts, as it does here (PB 16) that the limitation in question was "unnecessary". As the Court of Appeals correctly notes, however, that matter is no longer open to question because the file on the Pust patent which was available to the public "explicitly showed that in response to the Examiner's rejection, Pust had narrowed his claims" to include that limitation (PB 13a). The public in construing the scope of the patent is entitled to rely on that record. What mischief would result if every patentee could narrow its claims to avoid the prior art and obtain the patent, and then ignore those limitations in suing infringers.

The Court of Appeals properly declined "to undertake the speculative inquiry whether, if Pust had made only that narrowing limitation in its claim, the Examiner nevertheless would have allowed it." (PB 13a). Neither ought this Court undertake such speculation. To decide otherwise would be not only contrary to over half a century of established case law of this Court, but it would also be a clear invitation for misconduct by patentees and it would foster litigation to enable patent owners with unlimited funds for litigation to twist the meaning of claims like a "nose of wax" to their own liking—a prac-

tice this Court warned against a century ago in *White v. Dunbar,* 119 U.S. 47, 51-52 (1886). Thus, Deere's assertion that the limitation was "unnecessary" is mere lawyer's argument—contrary to the persuasive decisions of both lower courts.

As a separate and independent ground, Deere's contention that it was error not to apply the doctrine of equivalents should be rejected because, as the Court of Appeals noted (PB 14a):

> Deere has not given any convincing reason why we should enlarge the literal scope of the Pust patent claims. Such enlargement would be particularly inappropriate here, where we deal with 'improvement patents in a crowded art.' *Hughes Aircraft,* 717 F.2d at 1362, 219 USPQ at 481.

The range of equivalents to which a patent is entitled is a question of fact based on an assessment of the state of the art and the innovation represented by the invention. What the Court of Appeals found here is that this unnoteworthy invention is, on its merits, not entitled to any range of expansion beyond its literal terms, *Getty v. Lane,* 262 F. 141, 143 (1919).

Thus, the Court of Appeals' finding that the Pust patent (which expires in March, 1987) is not entitled to any scope beyond its literal terms is based on two independent grounds, each entailing a thorough review of the nature of the invention, the scope and content of the prior art, the differences between the invention and the prior art, and the prosecution history of two Pust patent applications—matters involving complex technical facts and inferences. That decision, based on settled law, does not merit this Court's review.

IV. The Court of Appeals' Conclusion Concerning Deere's Failure to Move for Directed Verdict Is Squarely Based On Settled Law and Does Not Merit Review.

Deere contends that this Court should grant review because the Court of Appeals enforced the explicit language of Rule 50, Fed. R. Civ. P., which makes a motion for directed verdict at the close of all evidence a prerequisite to a motion for judgment NOV. As the Court of Appeals held, it is settled law that where a party fails to move for a directed verdict on a specific issue, it may not subsequently challenge the jury's verdict on that issue by a motion for a judgment NOV. *U.S. Industries, Inc. v. Blake Construction Co.*, 671 F.2d 539, 548 (D.C. Cir. 1982). Deere would have this Court grant certiorari for the sole reason that, in Deere's opinion, the Court of Appeals erred in refusing to make an exception to that time-tested rule.

Although Deere did make a motion for directed verdict which specifically addressed other issues regarding these and other patents, Deere failed to move for a directed verdict on the contention that the Hansen and Brass-Hansen patents were invalid under § 102(a). The Court of Appeals concluded:

> In a motion for directed verdict, Deere raised a number of specific issues it urged the Court not to submit to the jury. It also included a general request for a directed verdict on Kinze's invalidity defenses, including the claim of obviousness based upon art not cited to the examiner. Deere, however, did not specifically refer in that motion to the prior public knowledge or use issue (PB 8a).

The jury found for Kinze on both issues, see Appendix A-I, Interrogatory 4.

In the Court of Appeals, Deere conceded that it had not addressed this issue in its directed verdict motion, but tried to excuse that failure on the ground that the issue was not "in the case" where Deere moved for directed verdict at the close of the evidence. The Court of Appeals reviewed the record, and decided that the issue was clearly raised by Kinze's submission of a proposed jury instruction and Deere acknowledged the issue by objecting to it, days before Deere's motion for a directed verdict. The Court concluded that by failing to renew its objection to submitting this issue to the jury in its directed verdict motion, Deere had waived its right to challenge the sufficiency of the evidence on that issue on motion for judgment NOV and on appeal.*

In petitioning for review, Deere once more changes its tune. The Court of Appeals having rejected Deere's argument that it could not have moved for a directed verdict on this issue because the issue was not "in the case", Deere now asserts that its objection to Kinze's proposed jury instruction on this issue should suffice in lieu of a directed verdict motion.

In support of this proposition, Deere cites two decisions. Neither decision holds that an objection to a jury

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* The Court of Appeals held (PB 9a-10a) that: (a) Kinze had introduced evidence on the issues during trial; (b) Deere objected to a proposed instruction regarding the issues claiming that the evidence was insufficient to submit this question to the jury; (c) Kinze's counsel retorted that this issue was indeed controverted and in the case; (d) Deere was on notice the issues were in the case; (e) several days later, after Kinze had rested its case, Deere moved for a directed verdict, omitting from that motion all reference to the § 102(a) issues. The Court of Appeals therefore concluded that Deere was on notice that this issue was in the case before it moved for directed verdict.

instruction is an acceptable substitute for a directed verdict motion. In the first of these, *Rochester Civil Theatre, Inc. v. Ramsay,* 368 F.2d 748 (8th Cir. 1966), the court held only that a general directed verdict motion, which did not specify grounds or issues, failed to preserve for review the sufficiency of the evidence on one of several independent affirmative defenses. Unlike the movant in the *Ramsay* case, Deere did specify the issues on which it sought a directed verdict and specifically omitted the issue in dispute. Since there was no objection to any jury instruction on the disputed issue in the *Ramsay* case, that court's pronouncement that such an objection might supplant a directed verdict motion is pure *dicta.*

Deere also cites *Bohrer v. Hanes Corporation,* 715 F.2d 213 (5th Cir. 1983). There, the defendants moved for a directed verdict at the close of the plaintiff's case. The court expressed its belief that the case did not warrant submission to the jury, but reserved its ruling on that motion, inviting the defendants to renew their attack by motion for judgment NOV or by motion for directed verdict at the close of all the evidence, which the defendants failed to do.

As the court noted in *Bohrer,* the primary function served by the directed verdict motion is to alert the opponent to the claimed evidentiary deficiency in his case while there is time to correct it, thus avoiding the "ambush" created where the court would entertain the claimed evidentiary deficiency for the first time on a motion for judgment notwithstanding the verdict. The court in *Bohrer* saw that this intrest had been served.

However, in the instant case, Deere never moved for a directed verdict on the disputed issue. Unlike the de-

fendants in *Bohrer*, Deere objected to an instruction on this specific issue, asserting a claimed evidentiary insufficiency, but then abandoned that contention days later by failing to assert it in a motion for directed verdict which raised all of Deere's other contentions. The conclusion of the Court of Appeals is clearly consonant with the principle underlying Rule 50: A party who would assert an evidentiary deficiency on a motion for judgment NOV must alert his opponent by making a motion for directed verdict at a time the opponent can cure that deficiency. Where, as here, Deere abandoned its argument on this issue, allowing Deere to raise it again on a judgment NOV motion would condone the very "ambush" the Rule is intended to prevent.

Deere would have this Court grant certiorari to review the Court of Appeals' failure to invoke an exception to the clear mandate of Rule 50 that required Deere to include reference to each issue which it challenged for alleged evidentiary insufficiency in its motion for directed verdict. Deere fails to cite any case holding that the tactics employed by Deere here did not constitute a waiver. Deere therefore fails to show either an error in the Court of Appeals' decision or a conflict between that decision and those of this Court or other Courts of Appeals. This Court ought not grant certiorari here merely to review the Court of Appeals' application of settled law to a specific factual record.

V. In Upholding the Invalidity of the Brass Patent for Prior Public Use, Well-Settled Principles of Patent Law Were Applied

The jury found the Brass* patent invalid under § 102(b) for having been placed in public use more than a year before the patent application was filed. The trial court denied Deere's motions for judgment NOV on "ample" evidence (PB 21a), and entered judgment on the jury's verdict. Based as it is on disputed evidence, this question is not worthy of review on a petition for certiorari because it would require the Court to weigh the evidence and determine what inferences could be drawn from the evidence. *Fire Insurance Association v. Wickham,* 128 U.S. 425, 435 (1888). The issue presents a mixed question of fact and law, determined by a properly instructed jury, and for that reason alone, is not a proper one for review by this overburdened court. *Jewell v. Knight,* 123 U.S. 426, 432 (1887). Further, this Court does not undertake review of concurrent findings of fact by two courts below, one of them having particular expertise on patent matters in the absence of a "very obvious and exceptional showing of error." *Graver Mfg. Co. v. Linde Co.,* 336 U.S. 271, 275 (1948). No such showing has been made here.

Even if error were present, an assumption we will soon show to be groundless, the district court declared it would have found these patents invalid as a matter of law for lacking nonobviousness under § 103 (PB 21a).

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* See Exhibit A-I, Interrogatory 10. The jury also found the Brass-Hansen patent invalid under § 102(b). Although Deere argues this latter finding on the merits, it is not properly before this Court because the Court of Appeals did not rule on it, as noted above.

To dispel Deere's claims that the jury's verdicts were based on passion not evidence, and to demonstrate that this Court ought not become involved in the factual quagmire supporting each of the seventeen verdicts in Kinze's favor, the evidence on this factual issue will be summarized.

The invention is a simple clutch device known *per se* in the pior art. It was made useful and practical as early as May of 1972 and ready for patenting (VI:1262-3), but the patent application was not filed until July of 1975—more than three years later. In June of 1972, the invention had been fully tested for function and underwent testing for stress, warranty, durability and "customer" acceptance (XI:3626). In the spring of '73, '74 and '75, machines made from production tooling were placed through Sales Branches to independent dealers who, in turn, placed the machines with their own "customers" for planting crops in the ordinary manner for which the machines were intended (PB 14a). This went on for three complete planting seasons before a patent application was filed because Deere was concerned about the "acceptability" of the new planter's appearance and therefore required "exposure to customers" (XI:3670).

Testing occurred in 16 states for a total of approximately 2500 hours (XV:5231) to plant 40,000 acres of crop (XI:3761)—the equivalent of *five rows of corn completely around the equator of the earth!* All this for a simple device known *per se* in the prior art and *after* the invention was ready for patenting!

Faced with overwhelming evidence of commercial use, Deere disclaimed that the testing was experimental and attacked only the sufficiency of evidence regarding wheth-

er the use was non-secret. As Judge Friedman noted (PB 15a-15b):

> At oral argument Deere's counsel explicitly eschewed any contention that the farmers' testing of the machines was not a public use because it was experimental, but "rel[ied] solely on the claim that the farmers' use was not public because it was secret".

As Judge Friedman noted, that was a fatal error, regardless of the argument of secrecy because the instruction (to which Deere did not take any exception relevant here, PB 15a) was drafted highly in favor of Deere—it required that the jury find the testing was *both* (1) not secret *and* (2) directed principally toward commercializing the invention.

The five-member panel unanimously found it unnecessary to address the question of secrecy because "even if the use was secret, its commercial character made it a public use." (PB 16a)

As the Federal Circuit held:

> A commercial use is a public use even if it is kept secret. (Citations omitted). While secrecy is one factor to be considered in determining whether the use was experimental or public, * * * secrecy alone does not necessarily negate public use.

The reason this is so was stated by this Court over 150 years ago in *Pennock v. Dialogue,* 27 U.S. (2 Pet.) 1, 18 (1829) which set forth the public policy that an inventor may not withhold knowledge of his invention from the public while furthering the use of his invention and then, only when the danger of competition forces him to apply for a patent, attempt to exclude the public from any further use. To hold otherwise would be to prolong the period of

patent monopoly beyond that set forth in the statute and would "materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries." 27 U.S. at 18.

Judge Learned Hand, in *Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, 520 (2d Cir. 1946), *cert. denied*, 328 U.S. 840 (1946) stated that it is a condition upon an inventor's right to a patent that he "shall not exploit his discovery competitively after it is ready for patenting." Rather, he must content himself "with either secrecy, or legal monopoly"; and an inventor forfeits his right to patent "regardless of how little the public may have learned about the invention" if he defies the fiat of Congress in failing to file within the prescribed time.

Deere argues that the Federal Circuit has committed error in this regard and based its decision "on a misapprehension of the law" (PB 21), stating "every case cited by the Federal Circuit in support of that proposition involved not only a secret use of a process later patented but also the *sale* of a product made by that process." According to Deere's reasoning, a "public use" must therefore necessarily involve a "sale". That is clearly not the law. Section 102(a) precludes *both* a "public use" *and* placing the invention "on sale" (which is broader than, and does not require, an *actual* sale). If, as Deere argued, every "public use" necessarily required a sale, the "public use" prohibition of the statute would be superfluous and even more restrictive than the broader "on sale" prohibition.

Realizing the error of its earlier position (namely, that commercialization of the invention was permissible as

long as it is carried out under a cloak of secrecy) only after disclaiming that the use was experimental, Deere now complains that the Federal Circuit erred in failing to apply the very exception which it eschewed before the Federal Circuit:

> All else aside, the conclusion of the Federal Circuit just flies in the face of the "experimental use" doctrine announced in *City of Elizabeth v. American Nicholson Pavement Co.*, (1877), 97 U.S. 126,

(PB 22).

Having specifically disclaimed that theory before the Federal Circuit, it is shameful for Deere to criticize that court for pursuing the path Deere alone selected. Even if it were possible for Deere to abrogate its disclaimer of experimental use (which as a matter of law it cannot now do), it certainly does not merit granting certiorari for the purpose of correcting yet another strategic error of Deere's lawyers especially since Deere's underlying position is faulty on both the law and the facts.

CONCLUSION

Deere has not carried its burden of establishing a single question of law which merits review by this Court. Deere's failure to support its arguments with authorative decisions or compelling reasons, like its failure to supply references to the record, are all telltale signs that Deere's petition to this Court is no more than a desperate attempt to obtain *de novo* review of a lengthy and complex case.

Respectfully submitted,

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APPENDIX

A-I

INTERROGATORY NO.	1	2	3	4	5	6	7	8	9	10	11	12	13
	§112 Best Mode	§112 Enabling Disclosure	§112 Distinctly Claimed	§102a Prior Use By Others	§103 Obvious	More Pertinent Art	Unenforceable Through Misconduct	Fraud on PTO	§102a Prior Printed Publication	§102b Prior Use	§102b On Sale	Infringement	Size of Gauge Wheel Larger Than Disc
PUST '495	▨	▨	▨	▨		X	X	▨	▨	▨	▨	▨	X
KEETON '578	▨	▨	▨	▨	X			▨	X	▨	▨		▨
HANSEN '601		X	▨	X	X			▨	▨				▨
BRASS/ HANSEN '668				X	X	X	X		▨	X	X		▨
BRASS '670	▨	▨	▨	▨	X	X		▨	▨	X			▨

X = Finding for Kinze Blank = Finding for Deere ▨ = Issue was not Submitted to Jury.

A-II

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF IOWA
CEDAR RAPIDS DIVISION

NO. C 80-20

JON E. KINZENBAW, an Individual; KINZE MANUFACTURING, INC., an Iowa Corporation,

Plaintiffs,

vs.

DEERE & COMPANY, a Delaware Corporation; EUGENE G. KEETON, an Individual,

Defendants.

ORDER

(Filed April 5, 1983)

This matter is before the court on the parties' March 18, 1983 motion and argument regarding the applicability of file wrapper estoppel to Patent No. Pust 3,499,495 and on the jury's March 29, 1983 verdict and answers to special interrogatories.

File Wrapper Estoppel

Plaintiff contends that defendants should be prohibited by the doctrine of file wrapper estoppel to read the claims of the Pust patent on the Kinze row unit or to rely on equivalency to make out infringement.

The doctrine of file wrapper estoppel provides that an applicant who acquiesces to rejection of his patent claim and accordingly modifies it to secure its allowance, will not

subsequently be allowed to expand or narrow his claim by interpretation to include limitations originally given up, or their equivalents. *Ellipse Corporation v. Ford Motor Company,* 452 F.2d 163, 168 (7th Cir. 1971), *cert. denied,* 406 U.S. 948 (1972), *reh. denied,* 409 U.S. 898 (1972); *Coleco Industries v. United States International Trade Commission,* 573 F.2d 1247, 1257 (CCPA 1978); *Tektronix, Inc. v. United States,* 455 F.2d 323, 328 (CCL 1971), *supplemented,* 552 F.2d 343, *reh. denied,* 557 F.2d 265, *appeal after remand,* 575 F.2d 832, *cert. denied, Hickok Elec. Instrument Co. v. Tektronix, Inc.,* 439 U.S. 1048 (1978). Thus, a necessary condition for the establishment of a file wrapper estoppel is that the patentee must have narrowed or broadened his claim in response to an objection by the Patent Office in order to obtain the patent. *Ellipse,* 452 F.2d at 168. The application of the doctrine is limited to changes made to overcome rejections by the Patent Office because the claim was anticipated by the prior art. Id. It will not apply where changes in the claim are directed to merely overcoming difficulties in wording or indefiniteness. Id.

The record here shows that on February 17, 1967, Waldo Pust filed an application for patent on a "Crop Seed Planting Device." On January 19, 1968 Pust filed a continuation in part application for the same invention claimed in the initial application and on March 29, 1968 he expressly abandoned the initial application in favor of the continuation application.

An examination was made of the continuation application and on November 15, 1968 all of the claims contained therein were rejected by the examiner as being obvious in view of the prior art and for other reasons.

Subsequently, on February 14, 1969, Pust filed an amended application and abandoned the claims contained in the previous application. Again, the examiner rejected the application for the reason that the claims presented were obvious in view of the prior art.

However, on June 25, 1969, applicant's attorney had a personal interview with the examiner which resulted in an amendment being made to claim 8 and the patent application being allowed.

The court has examined the file wrapper of the Pust patent and concludes that defendants should be estopped from reading the claims of the Pust patent on the Kinze row unit. In particular, claim 8 of the patent provides that the radius of the row unit gauge wheels should be less than the radius of the discs. Yet in the prior rejected applications, Pust showed that the size of the wheels relative to the disc made no difference. The important factor is the relative positioning of the wheels and the discs in relation to each other and to the ground. However, the examiner recognized that there existed prior art which taught that the dual scraping and compacting functions showed by Pust could be achieved by repositioning the gauge wheels relative to the discs and therefore rejected the applications. The attempt to now narrow the claim to require that the radius of the gauge wheel be less than that of the disc is nothing more than an attempt to narrow the claim by interpretation to include limitations previously rejected by the examiner.

Moreover, in its answer to Interrogatory No. 13, the jury found that the radius of the Kinze gauge wheel was larger than that of the disc. That finding is supported by

the evidence and precludes a finding of literal infringement of the claim.

Special Interrogatories

The court has reviewed the record and the jury's answers to special interrogatories and finds that all the answers are supported by sufficient evidence. Further, based upon those answers and all of the evidence in the case the court finds that Patent Nos. Keeton Re.27,578, Hansen 3,552,601, Brass-Hansen 4,009,668 and Brass 3,982,670, are invalid and Patent No. Pust 3,499,495 is unenforceable. Count I of defendants' counterclaim should be dismissed on the merits and plaintiffs awarded their costs of the patent action.

It is therefore

ORDERED

The clerk shall enter judgment in accordance herewith.

April 5, 1983

/s/ Edward J, McManus
Chief Judge
UNITED STATES
DISTRICT COURT